

Docket No. F-8064

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### REMARKS

Claims 2, 3, 13-20, 22-26, and 29-41 remain pending in this application. Claims 2, 3, 13-20, 22-26, and 29-41 are rejected. Claims 1, 4-12, 21, 27, and 28 are previously cancelled.

Claims 3 and 39-41 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,440,590 (Collins et al.)

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The office action has not demonstrated that the adhesive has a surface tension such that the adhesive moves smoothly on the upper surface of the pattern, as recited in claim 3.

Claim 39 recites applying an adhesive to the second surface of the pattern and contacting the adhesive to a substrate and applying heat or pressure to the transfer sheet. The Office Action's citation to column 1, line 67-column 2, line 2 of Collins et al. is referring to the application of the indicia from the temporary support sheet to the substrate. The adhesive cited on column 5, lines 31-37 of Collins et al. faces away from the substrate and is not in contact with it.

In claims 40 and 41, the first surface of the pattern is the surface that is originally in contact with the release layer and which eventually faces away from

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the substrate and is coated. In contrast, the coating described in column 2, lines 3-10 of Collins et al. cannot be applied or be in contact with the first surface of the pattern because the first surface of the pattern faces the substrate. Collins et al. discloses two transfer steps, resulting in the surface of the pattern which originally faces the liner sheet to eventually face the substrate. It is impossible to coat that surface with a protective coating since that surface faces the substrate.

Claim 2 has been rejected under Collins et al. as applied to claims 3 and 39-41 and further in view of U.S. Patent No. 3,131,106 (MacKenzie).

There is no indication that the adhesive is adapted to be capable of being colored by paint. Furthermore, Collins et al. discloses in column 4, lines 25-32 that the adhesive is removed before coating with paint, so there would be no need for the adhesive to be adapted to be capable of being colored by paint.

Claims 13, 15-18, 25, and 29-37 have been rejected under 35 U.S.C. § 103(a) as obvious over Collins et al. as applied to claims 3 and 39-41 and further in view of U.S. Patent No. 3,334,003 (F.G. Edwards).

To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974).

Regarding claim 13, the layer 15 that is brushed in F.G. Edwards is not an adhesive. Also, Examples 1 and 3 of Collins et al. disclose applying the adhesive by screen printing and there is no motivation to use a brush instead of screen

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printing, especially if the objective is to obtain a smooth coat of a desired thickness.

Regarding claims 15 and 16, the Office Action has not demonstrated that the surface tension of the upper surface of the pattern is larger than that of water or that the adhesive moves smoothly on the upper surface of the pattern because of the surface tension of the adhesive.

Regarding claim 29, the disclosure of Collins et al. makes it clear that the adhesive applied to an upper surface of the pattern is not directly contacted with the substrate since the adhesive faces away from the substrate when the pattern is applied.

Regarding claim 31, Collins et al. fails to disclose a remover layer being a remover sheet that is applied to the liner sheet.

Regarding claim 32, the spraying in F.G. Edwards is not of a remover layer.

Regarding claims 37 and 38, Collins et al. discloses in column 1, line 47-column 2, line 6 transferring the indicia from a transfer material to a temporary support sheet and then transferring the indicia to a substrate. Claim 37 recites one transfer step, not two. Since claims 37 and 38 utilize "consisting of" language, they exclude a second transfer step from their scope.

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Claims 14 and 23-24 have been rejected under 35 U.S.C. § 103(a) as obvious over Collins et al. in view of Edwards and further in view of U.S. Patent No. 6,582,803 (Cole et al.).

Claims 14 and 23-24 are patentable at least for the reason that they depend from a patentable base claim. See *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Claims 19-20 have been rejected under 35 U.S.C. § 103(a) as obvious over Collins et al. in view of Edwards and further in view of U.S. Patent No. 5,589,434 (Takahara et al.).

There is no reason to use paint or white paint in the adhesive of Collins et al. since Collins et al. discloses in column 4, lines 24-32 removing the adhesive so that paint can be applied and therefore teaches away from coloring the adhesive itself. The Federal Circuit has stated that generally, a reference that teaches away cannot serve to create a *prima facie* case of obviousness. See *In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Furthermore, the white pigment disclosed in Takahara et al. is added to improve the whiteness and hiding power of the dye receptor layer. The Office Action has not identified any reason to improve whiteness or hiding power in Collins et al., especially since the adhesive layer does not cover something that is to be hidden.

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Claim 22 has been rejected under 35 U.S.C. § 103(a) as obvious over Collins et al. in view of Edwards, in view of Takahara et al., and further in view of U.S. Patent Application Publication No. 2003/0121606 (Damico et al.).

Claim 22 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Claim 26 has been rejected under 35 U.S.C. § 103(a) as obvious over Collins et al. in view of Edwards, in view of Takahara et al., and in view of U.S. Patent Application Publication No. 2003/0121606 (Damico et al.) and further in view of Cole et al.

Claim 26 is patentable for similar reasons as stated above regarding claims 13, 15, and 19-20.

Furthermore, the adhesives disclosed in Takahara et al. on column 9, lines 49-55 are disclosed as having good adhesion property when being heated and such a characteristic would make it difficult in Collins et al. to remove the indicia from the temporary support sheet to apply the indicia to the substrate. The adhesive disclosed in Collins et al. is not utilized to adhere the indicia to the substrate and if heating increases the adhesion of the adhesive, then the transfer of the indicia to the substrate would be impaired because the adhesion to the temporary support sheet would increase at a point in time when the opposite is desired. Collins et al. specifically states in column 1, line 67-column 2, line 2 that the adhesion to the substrate must be greater than to the temporary support sheet and therefore there

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is a teaching away from utilizing in Collins et al. an adhesive which has good adhesion property when heated. The Federal Circuit has stated that generally, a reference that teaches away cannot serve to create a *prima facie* case of obviousness. See *In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Additionally, the adhesives disclosed in Takahara et al. are applied to a thickness of 0.5 to 10 $\mu$ m and the Office Action has not explained how this can be done with a brush.

Claims 13, 15-18, 29-30, and 33-37 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 1,897,875 (Werner) in view of Edwards.

Regarding claims 13 and 16, 29, and 37, no adhesive is being applied to a pattern in Werner since the cellulose ester solutions are part of the print itself.

Furthermore, there is no indication that the surface tension of the upper surface of the pattern is larger than the surface tension of water, as recited in claim 15.

Additionally, there is no remover layer disclosed in Werner as recited in claim 17.

Also, Werner does not disclose or suggest over-transferring a pattern on another pattern, as recited in claim 18.

Furthermore, Werner fails to disclose a resin toner, as recited in claim 34.

Claims 19-20 have been rejected under 35 U.S.C. § 103(a) as obvious over Werner in view of Edwards and further in view of Takahara et al.

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There is no adhesive used in Werner since the cellulose ester solutions are part of the print itself. Furthermore, coloring the cellulose ester solutions would change the color of the pattern.

Claim 22 has been rejected under 35 U.S.C. § 103(a) as obvious over Werner in view of Edwards in view of Takahara and in view of Damico et al.

Claim 22 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Claim 26 has been rejected under 35 U.S.C. § 103(a) as obvious over Werner in view of Edwards, Takahara et al., Damico et al., and Cole et al.

Claim 26 is patentable for similar reasons as claims 15, 17, 18, 19-20, and 34.

Additionally, Werner discloses in column 2, lines 61-63, the application of very high pressures of 200 kg/cm<sup>2</sup>. This is an enormous amount of pressure to apply with an iron. For example, assuming that the heating plate of an iron measures 3 inches by 7 inches (see attached for a description of an iron with total dimensions of 10 1/2 inches by 3 1/2 inches), this would provide 135.45 cm<sup>2</sup> of surface area. In order to apply 200 kg/cm<sup>2</sup> of pressure, the total pressure would have to be 27,090 kilograms. One of ordinary skill in the art is not capable of utilizing an iron to apply this much pressure and, accordingly, Werner teaches away from being modified in such manner.

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Also, there is no indication that the adhesives disclosed in Takahara et al. would work in Werner, especially since the objective in Werner is to adhere a print containing cellulose ester to a cellulose ester lacquer. The introduction of extraneous components would make the invention in Werner inoperable.

Accordingly, claim 26 is patentable over the cited art and notice to that effect is respectfully requested.

The Office Action states on page 21 that the claim language of "a remover sheet applied to a liner sheet" reads on coating a remover layer on a liner sheet. Applicant respectfully disagrees with the Examiner's interpretation. Claim 31 recites that "the transfer sheet comprises a remover layer and a liner sheet, said remover layer being a remover sheet that is applied to said liner sheet." The ordinary English meaning of a sheet being applied is that a sheet is applied and not that a coating is coated. Moreover, Fig. 8 shows a remover sheet being applied, not coated, supporting the Applicant's interpretation of claim 31.

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
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enc: description of an iron with total dimensions of 10 1/2 inches by 3 1/2 inches

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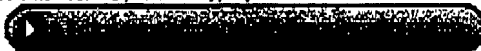
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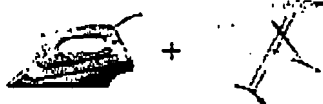
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